

REMARKS

Claims 33-64 are currently pending.

In the Office Action, the Examiner requires that the claims be restricted to one of the following three groups under PCT Rule 13.1:

Group I, claim(s) 33-40, drawn to a method for fabricating a tire.

Group II, claim(s) 41-52, drawn to a production plant for fabricating a tire.

Group III, claim(s) 53-64, drawn to an apparatus used as part of a production plant for fabricating a tire.

See Jan. 27, 2010, Office Action at 2.

Applicants respectfully traverse the restriction requirement. However, to be fully responsive, Applicants elect the subject matter of Group I, comprising claims 33-40. Applicants reserve the right to pursue the unelected subject matter in divisional applications.

The Examiner asserts that the "groups of inventions listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: USP 6183582 to Gregg shows that the subject matter of claim 53 is old in the art." *Id.* at 4. As an initial point, Applicants do not necessarily agree with or adopt the Examiner's characterization of U.S. Patent No. 6,183,582 and the claimed invention. Nonetheless, the Examiner's analysis has been directed against only Group III, and not Groups I and II. Whether or not Gregg shows the subject matter of claim 53 does not dictate that the Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1. Hence, the restriction is improper on its face.

Furthermore, Applicants respectfully refer the Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs the Examiner as follows:

If the search and examination of all the claims in an application can be made **without serious burden**, the examiner **must** examine them on the merits, even though they include claims to independent or distinct inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining Groups I to III together would constitute a serious burden, irrespective of whether or not they relate to single general inventive concept. The Examiner does not specify what serious burden will be placed on the Examiner if the Examiner were to proceed in examining Groups I to III together, as required by M.P.E.P. § 803.

Because Group I is elected, the Examiner additionally requires election of a single species from the following:

- A. A species in which a working fluid is admitted to the green tire before it is heated.
- B. A species in which a working fluid is admitted to the green tire while it is being heated.

See Jan. 27, 2010, Office Action at 2.

Applicants respectfully traverse this species election requirement. Nevertheless, to be fully responsive, Applicants elect, with traverse, "Species A." Accordingly, claims 33-35, 37-40 are under initial consideration.

The Examiner asserts that the "species are independent and distinct because they lack unity of invention for the reasons indicated below." *Id.* at 3. However, the Examiner provides no reasons below or above. As discussed above, the only analysis

with respect to unity of invention concerned Group III for which there was no election of species requirement. Hence, the election requirement is improper on its face.

To the extent there may have been a distinction between the "species," the Examiner also failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, inter alia, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. See M.P.E.P. § 803.02. Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden.

If the Examiner chooses to maintain the election of species requirement, Applicants expect the Examiner, if the elected species is found allowable, to continue to examine the full scope of the elected subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to a "reasonable" number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 

Anthony A. Hartmann
Reg. No. 43,662